

### **REMARKS/ARGUMENTS**

The rejections presented in the Office Action dated August 5, 2005, have been considered. Claims 1, 2, and 4-61 remain pending in the application. Reconsideration of the pending claims and allowance of the application in view of the present amendment and response is respectfully requested.

Applicant notes the Examiner's comments relating to the restriction requirement on paragraphs 1-3 of the Office Action. Applicant maintains the position that a search and examination of Groups I, IV, and V does not place an undue burden on the Examiner. In addition, with regard to the restriction of Groups I and II, the Examiner has not addressed Applicant's arguments that the Claims of Group I, as originally filed and particularly as amended, cannot be performed by hand, and thus the Examiner has not met the burden of proof as required under MPEP § 806.05(e). The Applicant thus maintains that it has not been properly established that the *process as claimed* is capable of being carried out by hand. By way of this traversal, the Applicants reserve the right to petition the requirement for election/restriction.

In addition, Applicant has added apparatus Claims 49-60 and computer readable medium Claim 61, which are related to Claims 1-24 as process and apparatus for its practice. Applicant submit that that Claims 49-61 are drafted in such a way that the apparatus claims are not independent and distinct from method claims because 1) the process cannot be practiced by another materially different apparatus nor by hand, and 2) the apparatus as claimed cannot be used to practice another and materially different process. Applicant submits that the search and examination related to newly added Claims 49-61 impose little or no additional burden on the Examiner over and above the search and examination already performed for Claims 1-24 and 41-48. Therefore Applicant respectfully requests that the Examiner enter new claims Claims 49-61.

Claim 7 stands rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement. Applicants respectfully traverse the rejection. The standard for determining compliance with the written description requirement is "whether the specification conveys with reasonable clarity to those skilled

in the art that, as of the filing date sought, applicant was in possession of the invention as now claimed.” MPEP § 2163.02. “The subject matter of the claim need not be described literally (i.e., using the same terms or *in haec verba*) in order for the disclosure to satisfy the description requirement.” *Id.* “The examiner has the initial burden of presenting by a preponderance of evidence why a person skilled in the art would not recognize in an applicant’s disclosure a description of the invention defined by the claims.” MPEP § 2163.04, quoting *In re Wertheim*, 541 F.2d at 263, 191 USPQ at 97.

The Examiner has states that “[t]he phrase ‘first format to a second format’ does not have support in the descriptive part of the specification.” The Applicant respectfully disagrees. The Examiner has not met the required burden of proof to show that Claim 7 is unsupported in the Specification, because a person skilled in the art would recognize that multiple instances of “converting from a first format to a second format” are described in the Applicant’s Specification. For example, the Applicant directs the Examiner’s attention to page 11, lines 10-12 of the instant Specification, which sets forth “convert[ing] the billing information in an incoming format to a format recognized by the charging and billing system.” In addition, page 15, lines 28-29 of the Specification recites “the bridge 404 can translate that information into a format that is meaningful to the ultimate charging/billing destination.” These excerpts demonstrate that the Specification conveys with reasonable clarity to those skilled in the art that, at the time of filing, the Applicant was in possession of the invention as set forth in Claim 7. Therefore Applicant respectfully requests the withdrawal of the rejection.

Claims 1, 2, 5, 7-24 and 41-48 stand rejected under 35 U.S.C. § 101 because the claimed invention is allegedly directed to non-statutory subject matter. Applicants respectfully traverse the rejection. In the Office Action, the Examiner states “[t]he claims do not recited [sic] technology within the body of the claim language.” The Applicants respectfully disagree. The standard for determining whether the claims are directed to statutory subject matter is set forth in MPEP § 2106 B.2.(b):

To be statutory, a claimed computer-related process must either: (A) result in a physical transformation outside the computer for which a practical application in the technological arts is either disclosed in the specification or would have been

known to a skilled artisan ..., or (B) be limited to a practical application within the technological arts.

Claims 1, 2, 5, 7-24 and 41-48 are directed to methods for managing charging and billing for services, which are clearly practical applications within the technological arts. Contrary to the Examiner's allegation, the claimed invention *as a whole* as set forth in Claims 1, 2, 5, 7-24 and 41-48 (including the terms "network" and "bridge module") *are* directed to statutory subject matter. Nonetheless, in order to advance prosecution, the Applicant has amended independent Claims 1 and 41 to include the limitations of originally filed Claim 3, which was not rejected under 35 U.S.C. § 101. Claim 3 has been canceled without prejudice and disclaimer, and Claim 4 has been amended to change its dependency. Applicants therefore submit that Claims 1, 2, 5, 7-24 and 41-48 as amended are directed to statutory subject matter, and respectfully request withdrawal of the rejection.

Claims 1-24 and 41-48 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,031,895 to *Cohn et al.* (hereinafter "*Cohn*"). Applicants respectfully traverse the rejections. According to MPEP §2142, to establish a *prima facie* case of obviousness under 35 U.S.C. §103:

- 1) there must be some suggestion or motivation either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings;
- 2) there must be a reasonable expectation of success; and
- 3) the prior art reference (or references when combined) must teach or suggest all the claim limitations.

Applicant submits that the Examiner has not presented a *prima facie* case of obviousness, because *Cohn*, even if modified pursuant to Official Notice taken by the Examiner, does not teach all the limitations of Claims 1-24 and 41-48. Applicant also respectfully submits that the assertion of Official Notice in the rejection of these claims is improper.

In the Office Action, the Examiner states:

*Cohn* discloses, e.g. Figs. 1-14, managing, e.g. 66, 70, 74, 151, billing for services [sic], e.g. 159, on a network system, e.g., 12, 14, 16, 18. *Cohn* does not explicitly

disclose receiving charging events and a network charging edge. Official Notice is taken that charging events, a network charging edge and bridging modules have been common knowledge in the communication art. To have provided such for *Cohn* would have been obvious to one of ordinary skill in the art.

Applicants respectfully assert that neither receiving charging events, nor using a network charging edge or bridging modules, constitute facts outside of the record which are capable of instant and unquestionable demonstration as being well-known in the art. The reference relied on in the Office Action, for example, fail to disclose this purportedly “well known” fact. Applicants contend that reasonable doubt exists regarding the circumstances justifying the Examiner’s exercise of Official Notice, and request that the Examiner provide evidence that demonstrates the appropriateness of the officially noticed facts pursuant to MPEP § 2144.03. Applicants reserve the opportunity to respond to the Examiner’s comments concerning any such judicially noticed facts.

In determining the differences between the prior art and the claims, the question under 35 U.S.C. § 103 is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious. Taking official notice of the above-discussed “facts” disregards the requirement of analyzing Applicants’ claimed subject matter as a whole. Applicants respectfully reiterate the legal tenet that facts so noticed should not comprise the principle evidence upon which a rejection is based. MPEP § 2144.03.

The Examiner has also failed to demonstrate that *Cohn*, even if modified pursuant to Official Notice taken in the Office Action, teaches or suggests all of the claim limitations of Claims 1, 2, 4-24 and 41-48. “All words in a claim must be considered in judging the patentability of that claim against the prior art.” MPEP § 2143.03, quoting *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970). The Examiner has not considered all of the words in Claims 1-24 and 41-48 in the rejection. The Examiner only states “*Cohn* discloses, e.g. Figs. 1-14, managing, e.g. 66, 70, 74, 151, billing for sevice[s] [sic], e.g. 159, on a network system, e.g., 12, 14, 16, 18.”

As to Claim 1, the Examiner has not demonstrated that *Cohn* teaches or suggests at least “receiving charging events at a network charging edge” or “managing charging transactions ... via the one or more bridge modules through the application of rules to

modify the charging transaction initiated by corresponding charging events.” Applicant submits that *Cohn*, even if modified pursuant to Official Notice taken by the Examiner, does not teach or suggest these features of Claim 1.

As to Claim 41, the Examiner has not demonstrated that *Cohn* teaches or suggests at least “receiving a plurality of charging information records generated by a plurality of network elements at a network charging edge,” “coordinating the charging information records into a user-session charging transaction at one or more bridge modules of the network charging edge,” or “executing the user-session charging transaction at the one or more bridge modules of the network charging edge according to second predetermined rules.” Applicant submits that *Cohn*, even if modified pursuant to Official Notice taken by the Examiner, does not teach or suggest these features of Claim 41.

In FIG. 13, *Cohn* illustrates a single billing system 159 directly coupled a central access and control system 155. *Cohn* provides scant detail as to the operation of the billing system. Most of detail that *Cohn* provides regarding the billing system is set forth in col. 33, lines 50-55:

The billing system 159 within the network center 37 interacts with the central access and control system 155 which in turn stores and processes all of the billing events that occur on communications system 10 to create billing records associated with services performed by the communications system 10.

This is a vague and generic description that could apply to numerous computerized billing systems. *Cohn* is silent on any details of “interactions” of the billing system, therefore *Cohn* does not teach or suggest all of the limitations of the rejected claims. The elements 66, 70, 74, and 151 in *Cohn* relied upon by the Examiner as showing “managing” merely show a control processor 66, an event processor 70, a connection manager 74, and a database 151. These structural elements provide generalized system control, and *Cohn* does not teach or suggest that these elements “manage” any aspect of billing transactions, no less all of the limitations of Claims 1 and 41.

Because the Office Action has not addressed all the claim language of at least independent Claims 1 and 41, the rejection is improper. Because *Cohn*, even if modified pursuant to the Official Notice taken by the Examiner, does not teach or suggest all the

limitations of Claims 1 and 41, a *prima facie* cause of obviousness has not been established. Therefore, Claims 1 and 41 are allowable over *Cohn*.

The Examiner has also failed to demonstrate that *Cohn* teaches or suggests all of the limitations of independent Claims 2, 4-24 and 42-48. These claims recite additional features which further distinguish these claims over the art, and any rejections of these claims under 35 U.S.C. 103(a) must address the particular language used in each claim. Because none of the language of Claims 2, 4-24 and 42-48 was addressed in the rejection, Applicant respectfully submits this rejection is improper.

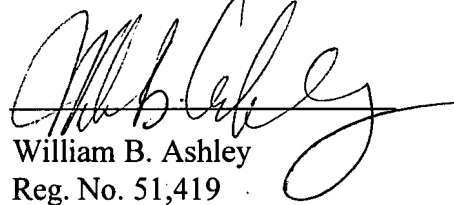
In particular, the rejection of Claims 1, 2, 4-24 and 41-48 is improper because the Examiner has grouped all of Claims 1, 2, 4-24 and 41-48 in a common rejection. According to MPEP § 707.07(d), “[a] plurality of claims should never be grouped together in a common rejection, unless that rejection is equally applicable to all claims in the group.” Applicants submit that independent Claim 1 and 41 recite features that render these claims distinguishable from each other. In addition, Claims 2, 4-24 depend from Claim 1 and Claims 42-48 depend from Claim 41. These dependent claims include all of the limitations of the base claim and any intervening claims, and recite additional features which further distinguish these claims from Claims 1 and 41, as well as distinguishing them over *Cohn*. Therefore a common rejection of Claims 1, 2, 4-24 and 41-48 is improper. In addition, Claims 2, 4-24 and 42-48 are allowable over *Cohn* because, as asserted above, *Cohn* does not teach or suggest all of the limitations of Claims 1 and 41 from which Claims 2, 4-24 and 41-48 respectively depend. Because *Cohn* does not teach or suggest all the limitations of Claims 2, 4-24 and 41-48, a *prima facie* case of obviousness has not been established and these Claims 2, 4-24 and 41-48 are allowable over *Cohn*.

In conclusion, the Applicant respectfully submits that Claims 1, 2, 4-24 and 41-48 are in condition for allowance. If the Examiner believes it necessary or helpful, the undersigned agent of record invites the Examiner to contact him at 952.854.2700 to discuss any issues related to this case.

Respectfully submitted,

Date: January 25, 2006

By:

A handwritten signature in black ink, appearing to read 'W. B. Ashley', written over a horizontal line.

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